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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

RIMELL, SAMUEL G

ART UNIT PAPER NUMBER

2165

DATE MAILED: 01/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/394,661

Applicant(s)

TSUJI, MASAOKI

Examiner

Sam Rimell

Art Unit

2165

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


SAM RIMELL
PRIMARY EXAMINER

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Art Unit: 2175

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 5 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 5: Claim 5 has been amended to reference a predetermined period “based on a number of data sectors corresponding to the subcode component data prior to the alteration.” The principle of the alternating period being based on or influenced by the number of data sectors in considered new matter in relation to the original disclosure.

The only portion of the original disclosure that appears to discuss these features is page 48, lines 14-19, which state the following:

“As mentioned above the subcode P data is data which toggles every 75/4 seconds between the High state and the Low state by counting sectors based on the original data of the subcode P data. The period of the toggling is 75/2 seconds.” (emphasis added).

This statement from the specification indicates that the sectors of original subcode P data are counted as part of the toggling process. However, the specification does not state that the toggling period (which corresponds to the predetermined period in claim 5) is variable in any way, or is dependent on what is actually counted.

In view of these considerations, the features recited above which have been amended into claim 5 are considered to be new matter.

Art Unit: 2175

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4 are rejected under 35 U.S.C. 102(e) as being anticipated by Kawamura et al. (U.S. Patent 6,075,920).

Claim 1: FIG. 1 of Kawamura et al. discloses a control unit (20) which controls a first generating portion (9) which generates time code information. The control unit (20) itself is a second generating portion that generates non-time-code information, such as sector number, copyright management information, track number, application ID number, application information and layer information (see right arrow extending from control unit). The time code information and non-time-code information are each components of subcode that are entered into a subcode generator (11) which outputs subcode. The control unit maintains controls over the output of the time code information and non-time-code information, and thus can be read as a selecting portion which selects output. The system incorporates first and second commands. The first command is from the control unit to time code generator (9) to generate time codes (col. 9, lines 24-25). The second command is a command received and processed by the control unit (20) to generate the non-time code information (col. 10, lines 24-32). Additionally, it is observed that the time code information has a plurality of components (FIG. 11) and the non-time code information has a plurality of components (sector number, copyright management information,

track number, application ID number, application information and layer information, as seen in FIG. 1).

Claim 2: The second generating portion outputs six types of data, and can thus be said to comprise a plurality of generating portions.

Claim 3: See remarks for claim 1. Also note table of FIG. 6, which is a data table in memory having separate table locations (memory areas) for metadata (commands) associated with the time code data and non-time code data.

Claim 4: See claims 2-3.

Remarks

Applicant's arguments and amendments have been considered.

The rejection of claim 5 under 35 USC 112, first paragraph has been maintained. The fundamental issue which arises in claim 5 is that the specification does not correlate the actions of counting sectors to determining the alternating period. The specification does state (page 48, lines 15-19) that counting of sectors does occur during the alternating period, but it does not state that the number counted sectors influences the length of the period, which is what is being suggested in claim 5. Accordingly, the rejection has been maintained.

The rejections of claims 1-4 under 35 USC 102(e) has been maintained. Applicant argues that the reference to Kawamura does not disclose the automatic generation of a plurality of time code information in response to a single command, and the automatic generation of a plurality of non-time code information in response to a single command. Notwithstanding the fact that the claims do not use the terms "single command", examiner maintains that Kawamura et al. teaches these features. FIG. 1 illustrates a control unit (20) that issues a first command to

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generate the time code information (col. 9, lines 24-25) and receives and processes a second command to generate the non-time code information (col. 10, lines 24-32). Accordingly, examiner maintains that these features are fully taught by Kawamura et al.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Sam Rimell at telephone number (571) 272-4084.



Sam Rimell
Primary Examiner
Art Unit 2175